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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,606	08/01/2006	Karl J. Wood	GB 040030	3714

24737 7590 05/11/2009
PHILIPS INTELLECTUAL PROPERTY & STANDARDS
P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

EXAMINER

CHOWDHURY, NIGAR

ART UNIT	PAPER NUMBER
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2621

MAIL DATE	DELIVERY MODE
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05/11/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/597,606	Applicant(s) WOOD, KARL J.	
	Examiner NIGAR CHOWDHURY	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in United Kingdom on 02/03/04. It is noted, however, that applicant has not filed a certified copy of the 0402273.7 application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-6, 8-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,311,011 by Kuroda in view of US 6,642,939 by Vallone et al.
2. Regarding **claim 1**, Kuroda discloses a method for configuring the storage capacity of a recording apparatus used for storing at least one AV content item (fig. 3), the method comprising:
 - storing a content item (fig. 2 (103, 105));
 - reproducing the stored content item for review by a user (col. 4 lines 54-57, col. 12 lines 28-44);
 - where a pre-determined condition occurs, prompting the user for a response (col. 4 lines 12-17); and

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- configuring the storage capacity used for storing the content item according to the user response (col. 4 lines 47-49, fig. 3, col. 5 lines 12-col. 6 lines 4).

Kuroda fails to disclose while reproducing the stored content item, analysing the reproduction of the content item to identify the occurrence of a pre-determined condition.

Vallone discloses while reproducing the stored content item, analysing the reproduction of the content item to identify the occurrence of a pre-determined condition (fig. 20, col. 17 lines 56-67).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the proposed combination of Kuroda's system to include pre-determined condition during reproduction, as taught by Vallone, for having more flexibility to a user while watching a program with pre-defined condition.

3. Regarding **claim 2**, Kuroda discloses a method wherein the stored content item is a recording of a live broadcast content item and is reproduced contemporaneously with the live broadcast content item (col. 12 lines 28-44).

4. Regarding **claim 3**, Kuroda discloses a method wherein the pre-determined condition comprises identifying the end of the content item (col. 4 lines 12-17).

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5. Regarding **claim 4**, Kuroda discloses a method wherein the content item comprises video and the end of the item is identified by detecting credits present at the end of the item (col. 4 lines 12-17).

6. Regarding **claim 5**, Kuroda discloses a method wherein the pre-determined condition further comprises identifying the start of the content item and the user is prompted when both the start and end of the content item have been identified (col. 2 lines 25-33).

7. Regarding **claim 6**, Kuroda discloses a method wherein the storage capacity used for storing the content item is configured to maintain storage of the content item in the case where there is no user response to the prompt (col. 4 lines 51-53).

8. Regarding **claim 8**, Kuroda discloses a method wherein storage is maintained for a pre-determined period of time (fig. 3-5, col. 5 lines 12-col. 6 lines 4).

9. Regarding **claim 9**, a method wherein configuring the storage capacity is the release of capacity (col. 4 lines 47-53, fig. 3-5, col. 5 lines 12-col. 6 lines 4).

10. Regarding **claim 10**, a method wherein the release is conditional on archiving the content item (col. 4 lines 47-53, fig. 3-5, col. 5 lines 12-col. 6 lines 4).

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11. Regarding **claim 11**, Kuroda discloses an AV content recording apparatus, the apparatus comprising:

- an input arranged to receive a content item (fig. 2 (101), col. 4 lines 12-17);
- a store operable to store the content item (fig. 2 (103, 105)) and to reproduce the content item under the direction of a processor (fig. 2 (104));
- a first output arranged to output the reproduced content item (col. 4 lines 25-57);
- a second output arranged to output a prompt signal (col. 4 lines 25-57);
- a user interface operable to render the prompt signal and to accept user inputs (fig. 9 (809), col. 10 lines 60-67);
- a receiver device operable to receive a response from the user interface (col. 9 lines 16-31); and
- a processor, a program memory and a data memory all interconnected by means of a bus (fig. 2 (107)), the processor being operable under control of a program contained in the program memory to:
 - direct the storage of a content item (fig. 2 (103, 105));
 - direct the reproduction of the content item for review by a user (col. 4 lines 54-57, col. 12 lines 28-44);
 - where a pre-determined condition occurs, prompt the user for a response (col. 4 lines 12-17); and

- configure the storage capacity used for storing the content item according to the user response (col. 4 lines 47-49, fig. 3, col. 5 lines 12-col. 6 lines 4).

Kuroda fails to disclose during reproduction of the stored content item, analyse the content item to identify the occurrence of a pre-determined condition;

Vallone discloses during reproduction of the stored content item, analyse the content item to identify the occurrence of a pre-determined condition (fig. 20, col. 17 lines 56-67).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the proposed combination of Kuroda's system to include pre-determined condition during reproduction, as taught by Vallone, for having more flexibility to a user while watching a program with pre-defined condition.

12. Regarding **claim 12**, Kuroda discloses an apparatus further comprising a tuner operable to provide a content item to the input (fig. 2 (102))

13. Regarding **claim 13**, Vallone discloses an apparatus further comprising a player operable to reproduce a content item from a removable media and provide the item to the input (fig. 13, col. 13 lines 11-20)

14. Regarding **claim 14**, Kuroda discloses an apparatus wherein the store comprises a hard disk drive (fig. 2 (103), col. 4 lines 25-27).

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15. Regarding **claim 15**, Kuroda discloses an apparatus wherein the store comprises a removable media (fig. 2 (105), col. 4 lines 38-46).

16. Regarding **claim 16**, Kuroda disclose an apparatus wherein the presentation device is a display and the reproduced content item and prompt signal are video signals for rendering on the display (col. 4 lines 25-57).

17. Claims 7, 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,311,011 by Kuroda and US 6,642,939 by Vallone et al. in view of US 2002/0174430 by Ellis et al.

18. Regarding **claim 7**, Kuroda discloses a store operable to store the content item (fig. 2 (103, 105)), and Vallone discloses during reproduction of the stored content item, analyse the content item to identify the occurrence of a pre-determined condition (fig. 20, col. 17 lines 56-67) but both fail to disclose a method wherein the stored content item is a recording of a rented content item and a subsequent reproduction of which is conditional on an authorisation.

Ellis discloses a method wherein the stored content item is a recording of a rented content item and a subsequent reproduction of which is conditional on an authorization (fig. 67, paragraph 0008, 0037, 0395, 0396).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the proposed combination of Kuroda and Vallone's

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system to include rented content item and authorisation, as taught by Ellis, to an each user to have their own login identification for privacy and more flexibility to a user to have rented content while watching a program.

19. Regarding **claim 17**, Kuroda discloses a store operable to store the content item (fig. 2 (103, 105)), and Vallone discloses during reproduction of the stored content item, analyse the content item to identify the occurrence of a pre-determined condition (fig. 20, col. 17 lines 56-67) but both fail to disclose an apparatus further comprising a first interface operable to communicate with an authorisation device .

Ellis discloses a method wherein the stored content item is a recording of a rented content item and a subsequent reproduction of which is conditional on an authorization (fig. 67, paragraph 0395, 0396).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the proposed combination of Kuroda and Vallone's system to include authorisation, as taught by Ellis, to an each user to have their own login identification for privacy while watching a program.

20. Regarding **claim 18**, Ellis discloses an apparatus wherein the first interface is a modem for connecting to an Internet server (paragraph 0158, 0162) operable to authorise the reproduction of a content item held in store (fig. 67, paragraph 0395, 0396).

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21. Regarding **claim 19**, Ellis discloses an apparatus further comprising a second interface operable to communicate with an archiving device (paragraph 0157-0158, 0162).

22. Regarding **claim 20**, Ellis discloses an apparatus wherein the second interface is Ethernet for communicating with a server or removable media recorder (paragraph 0157-0158, 0162).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NIGAR CHOWDHURY whose telephone number is (571)272-8890. The examiner can normally be reached on 9 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NC

05/09/2009

/JAMIE JO VENT ATALA/
Examiner, Art Unit 2621